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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,225

03/23/2004

Donald V. Edwards

SIM 04023

8484

7590 11/06/2007
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EXAMINER

WATSON, ROBERT C

ART UNIT

PAPER NUMBER

3723

MAIL DATE

DELIVERY MODE

11/06/2007

PAPER

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The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/807,225
Filing Date: March 23, 2004
Appellant(s): EDWARDS, DONALD V.

Amos Bartoli
For Appellant

EXAMINER'S ANSWER

MAILED
NOV 06 2007
GROUP 3700

This is in response to the appeal brief filed 9/13/07 appealing from the Office action mailed 3/20/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,570,192	Younick	01-1926
3,700,212	Morgenberger	10-1972
6,354,570	Christensen et al	03-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 4, 9-11, 14, 16, and 27 stand rejected under 35 U.S.C. 102(b) as being anticipated by Younick.

Younick shows an apparatus for applying upward pressure to an object. The apparatus includes a first means 6, an elongated rod 1, a second means 4, and a third means 7. The **third means 7 “engages the support 3”** (Younick, column 2, line 13). This is construed by the examiner as **engaging the support 3 always even during a prying operation**. Clearly, the tool operates by third means 7 supporting and pivoting said apparatus. Even if the third means 7 supported and pivoted the apparatus for a small infinitesimal time it would read on the claim language. Since the third means 7 “engages the support 3” it must necessarily be on an underside of the second means. The bottom of third means 7 is at least coplanar with the underside of the second means 4 which is interpreted as being “on the underside of the second means 4” since this is a broadly written phrase subject to various interpretations. The second means, the object engaging means, is disclosed as being a “flattened end 4” (Younick, column

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2, line 3). This tapered laterally broadened flattened end as shown Figure 1 of Younick provides an object engaging means having a predetermined surface bearing area which is at least sufficient to prevent sidewise tipping of said apparatus during use. Since the Younick device is a "wrecking bar", the examiner takes Official Notice that wrecking bars are commonly made from steel and that steel would have the strength characteristics recited in the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Younick in view of Morgenberger and Christensen et al.

Morgenberger teaches that various object and user hand engaging portions of the lifting lever may include grips or caps to cover the extremities of these engaging portions. To provide grips or caps on any of the object and user hand engaging portions of Younick would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Morgenberger. One skilled in the art would have been motivated to do this in order to prevent the tool from slipping out of the users hand or slipping relative to the object being engaged and to prevent marring of the objects that are engaged by the tool.

Christensen et al teaches that the object engaging portions of a lever may be made from rubber or plastics. The examiner takes Official Notice that a common

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plastic is polyethylene. To make any engaging portion in Younick from polyethylene would have been obvious at the time of the invention in view of the teachings of Christensen et al. One skilled in the art would have been motivated to select polyethylene for the engaging portions since it is a readily available material and would have the desired anti-slip characteristics and would prevent marring of the objects engaged therewith.

(10) Response to Argument

Applicant's principle argument is that "The third means [7] of Younick is not a pivoting means nor can it act as such" (Brief, "vii", lines 45-46). Applicant further argues that "The bar 7 of Younick is not on the underside of bar 2." (Brief, "vii", lines 59-60). Apparently Applicant takes the narrow position that bar 7 of Younick is only for the purpose of providing lateral support and the prevention of twisting of the lever during use. The examiner finds Applicant's narrow interpretation of the functioning of bar 7 of Younick to be in error.

Firstly, Figure 2 of Younick shows unequivocally that bar 7 is in contact with support 3. Therefore, bar 7 must be on the underside of bar 2. What other conclusion is possible? Applicant offers no other alternative conclusion. Secondly, the Younick specification unequivocally states that the bar 7 contacts the support; ie., "...**outward engaging arms 7...engage the support 3 at opposite sides of the bar.**" (Younick, column 2, lines 50-53). Since bar 7 is in contact with the support 3 then, of course, the only reasonable conclusion that can be made is that rocking of the first end (handle end 6) of the lever would therefore cause the lever to pivot about the place where the tool

contacts the support 3; ie., cause the lever to pivot about the bar 7 located on the underside of the bar. Younick discloses that the bar 7 prevents twisting of the tool from side to side during a prying operation (Younick, column 2, lines 54-54). If one skilled in the art were confronted with Applicant's erroneous assertion that bar 7 of Younick does not contact the support 3 then it is respectfully submitted that the first question one skilled in the art would ask is. "if bar 7 doesn't contact the support during prying then how does bar 7 prevent twisting of the tool from side to side during a prying operation? Doesn't bar 7 have to contact something in order to prevent the twisting of the tool?" It is respectfully submitted that adopting Applicant's erroneous assertions with respect to the Younick tool can lead to only anomalous results.

Applicant further alleges that with respect to claim 27 Younick does not have an "elongate object engaging means having a predetermined surface bearing area which is at least sufficient to prevent sidewise tipping of said apparatus during use". It is respectfully submitted that the tapered laterally broadened flattened end 4 as shown Figure 1 of Younick provides an object engaging means having a predetermined surface bearing area which is at least sufficient to prevent sidewise tipping of said apparatus during use.

Applicant further argues that there is "no motivation" for combining the Morgenberger and Christensen et al references with the Younick reference under 35 USC 103. The examiner respectfully submits that the reasons articulated by the examiner for combining the references fully complies with the "KSR" decision.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert C. Watson". The signature is fluid and cursive, with a long horizontal stroke extending to the right.


Robert C. Watson,

Primary Examiner

Conferees:

Joseph J. Hail, 

SPE

Allan N. Shoap, 

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10807225	3/23/04	EDWARDS, DONALD V.	SIM 04023

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Robert C. . Watson

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